

## **REMARKS**

This application has been carefully reviewed in view of the Office Action mailed June 24, 2008. All rejections are respectfully traversed and reconsideration is respectfully requested.

Claims 38-43, 45, 46, 48-54, 56-62, 72-79, and 84-105 are pending in the present application. No claims are added, canceled or amended by this response.

The undersigned appreciates the Examiner's removal of the finality of the prior Office Action mailed March 17, 2008. The undersigned also appreciates the Examiner's removal of Official Notice with respect to claim 49.

## **Interview Request**

The undersigned respectfully requests the courtesy of a telephone interview with the Examiner at the Examiner's earliest convenience. The undersigned can be reached at the telephone number below.

## **Regarding the Rejections**

Applicant respectfully submits that the Patent Office has failed to properly respond to Applicant's arguments presented within the prior Response to Office Action filed December 3, 2007 and the Response to Office Action filed April 24, 2008. Applicant additionally provided arguments and a table within the previous Response filed April 24, 2008 detailing defects in the rejections that were issued in the Final Office Action dated March 17, 2008. Applicant incorporates the previous arguments within the two prior Responses filed December 3, 2007 and April 24, 2008 by reference as if fully set forth herein.

The Patent Office has improperly not addressed Applicant's prior arguments within the present Office Action dated June 24, 2008. The present Office Action appears to be a copy and paste of the prior Final Office Action dated March 17, 2008, with only removal of the finality and Official Notice referenced above. It is noted that MPEP 707.07 (f) requires "[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note

of the applicant's argument and answer the substance of it" in order to fulfill the requirements of 37 C.F.R. 1.104. The present Office Action is not in compliance with this requirement.

The Patent Office has erred in not establishing that the cited references show several elements of Applicant's claims that were previously argued as missing from the cited references. For the record, the Patent Office is reminded that the video products of U.S. Patent No. 5,530,754 to Garfinkle that are relied upon by the Patent Office describe distinct video products that are separately stored and separately addressed within a catalog store. (See Garfinkle, col. 3, lines 44-49; and FIG. 2, separate address fields 42, 44, and 46). A customer accesses a menuing system associated with the catalog store to select and order the distinct video products from the separately addressed storage locations as part of a single transaction. (See Garfinkle, col. 3, lines 56-58).

The Patent Office has not shown where at least the following elements, among others, are found within the cited references, using claim 38 as an example.

- The Office Action admits that Garfinkle fails to explicitly disclose the claim feature of presenting the customer with an opportunity to acquire additional rights to a selected portion of the A/V content. There is no teaching, suggestion, motivation or articulated reasoning presented within the Office Action for "presenting the customer with an opportunity to complete a transaction to acquire additional rights to a selected portion of the A/V content". (emphasis added.)
- The Office Action fails to identify a teaching, suggestion, motivation or articulated reasoning that supports "presenting a customer with an opportunity [to complete a transaction to acquire additional rights to a selected portion of the A/V content] in a menu displayed just prior to, during, or just after presentation of the full selection of A/V content."

- The Office Action fails to identify a teaching, suggestion, motivation or articulated reasoning that supports enabling the customer to “store the selected portion.” (emphasis added).
- Any proposed combination of the cited references lacks the claimed features associated with selection of a portion of an item of A/V content for which rights have already been obtained, obtaining rights therefor, and storage of same. (emphasis added). The claim features noted above are absent and there has been no articulated reasoning as to why one of ordinary skill in the art would find making the proposed combination and supplying the missing elements to be obvious.

Fundamental to *Graham v. John Deere*, 383 U. S. 1 (Supreme Court, 1966), for the Patent Office to combine references in an obviousness rejection, the Patent Office must first establish *prima facie* obviousness by showing where each and every element is taught or suggested in the combined references. This showing is required as a part of identification of the scope and content of the prior art. The Patent Office has repeatedly failed to satisfy this requirement for an obviousness rejection because the Patent Office has repeatedly failed to show where at least the elements described above are shown within the combination of references.

Multiple claim elements are missing from the combination of references, and the Patent Office has failed to provide any articulated reasoning as to why one of ordinary skill in the art would find the claims as a whole to be obvious in the absence of the claim features not present in the cited art (See *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006), as explicitly endorsed by the Supreme Court). Such an analysis is required in order to satisfy the factual inquiry ascertaining the differences between the prior art and the claims at issue. The Patent Office has repeatedly failed to satisfy this additional requirement for an obviousness rejection because the Patent Office has repeatedly failed to properly identify the missing elements within the cited references.

Accordingly, the Patent Office has failed to establish *prima facie* obviousness for at least these two fundamental reasons and the present rejections should be withdrawn. Applicant

respectfully submits that the present application is in condition for allowance and notice of the same is requested at the earliest possible date.

As an additional consideration, the errors associated with the Response to Arguments section were presented in the previous Response to Office Action filed April 24, 2008. These errors were maintained within the present Office Action dated June 24, 2008. The errors associated with the Response to Arguments are re-presented below in the following section of this paper for the Patent Office's further consideration.

#### **Regarding the Response to Arguments**

Applicant again appreciates the Examiner's efforts in responding to the arguments presented in the prior Office Action Response. However, Applicant again notes that the rejections in question are obviousness rejections, but the Examiner's explanation relates to the law of anticipation, and hence suggest that the claim elements are "fully met" by "the reference". It is noted, however, that the rejections in question are obviousness rejections and the requirements of *Graham v. Deere, In re Kahn* (cited in prior response), and more recently affirmed in *KSR v. Teleflex*, 82 USPQ2d 1385 (S.Ct.2007) require that each element of the combination must be accounted for in the cited art and that there must be an articulated reasoning as to missing elements or a missing reasoning for making the combination claimed.

The Examiner again incorrectly states that Applicants "misinterprets the principle that claims are interpreted in light of the specification. Although these elements are found as examples or embodiments of the specification, they are not claimed explicitly." Applicants again respectfully disagree. If the Examiner studies the antecedent basis of the language used in the claims it will become clear that the claims distinguish over purchase of "distinct and separate video products" as previously argued. An example, claim 38 was again broken down in table form within the previous Response to Office Action filed April 24, 2008, in part to illustrate how the explicit claim language in fact distinguishes. If after review of this language the Examiner is not convinced and would like to offer a proposal that clarifies the intended meaning, the

undersigned would be delighted to discuss it with him and reiterates the interview request presented above.

While the Examiner's efforts in responding to this deficiency are appreciated, they are clearly deficient in view of the continued failure to provide an appropriate articulated reasoning that renders any deficiencies in the cited combination of art obvious to one having ordinary skill in the art.

### **Conclusion**

In view of the multiple clear distinctions pointed out above, further discussion is believed to be unnecessary at this time. Failure to address each point raised in the Office Action should accordingly not be viewed as accession to the Examiner's position or an admission of any sort. Applicants reserve the right to provide additional arguments if necessary in relation to any of the rejected claims.

In view of the discussion above, claims 38-43, 45, 46, 48-54, 56-62, 72-79, and 84-105 are clearly in proper condition for allowance. Reconsideration is respectfully requested and notice of allowance for all pending claims is respectfully requested at the earliest possible date.

If any issues remain, the Examiner is once again encouraged to contact the undersigned to expedite allowance and issue and avoid the necessity and expense of appeal or petition. The undersigned looks forward to an interview with the Examiner.

Respectfully submitted,

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Dated: 9/23/08

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